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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,451	11/29/2001	Josef Lehmkuhl	2001-0574A	4277

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EXAMINER

BOS, STEVEN J

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 08/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,451

Applicant(s)

LEHMKUHL ET AL.

Examiner

Steven Bos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

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Claim 18 is objected as ungrammatical in c). It appears that – and added to at least one mineral acid – was intended.

Claim 19 is objected to as it is ungrammatical.

Claim 25 is objected to as it is ungrammatical. In line 1, “in that” should be deleted.

Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The recitation of “the precipitate optionally being further processed” fails to further limit claim 18 since claim 18 requires such further processing.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, "by a chemical reaction ... calcium (hydr)oxide" is indefinite as to what "a solid or dissolved and suspended, respectively" is or means. Also, "calcium (hydr)oxide" is indefinite as to what this is or means. If it means either calcium hydroxide or calcium oxide then this should be recited.

In claim 18, "in a manner known per se" each occurrence, is indefinite as to what the metes and bounds of this phrase are.

In claim 18, c, "in step (b)" is indefinite as to what this refers to since the recited "b)" is not referred to as "step (b)".

In claim 18, c, "aluminatesalt" is indefinite as to what this is and it appears that – aluminate salt – was intended.

In claim 18, d, "the precipitate" is indefinite as to which one this refers to, the one in a, or b, or c.

Claim 20 is indefinite as to what "respectively" refers to; ie. respective to what?

Claims 21,22 are indefinite as to what "step (a)" refers to since no step is recited in claim 18 from which these depend. Also, "calcium (hydr)oxide" is indefinite as to what this is or means. If it means either calcium hydroxide or calcium oxide then this should be recited.

Claim 24 is indefinite as to what "step (a)" refers to since no step is recited in claim 18 from which it depends.

Claim 25 is indefinite as to what "step (b)" refers to since no step is recited in claim 18 from which it depends.

In claim 25, "preferably ..." and "... in particular ..." and "... and, alternatively ..." in combination render the claim indefinite and confusing as to what the metes and bounds of the claim are.

In claim 27, "respectively" is indefinite as to what this is to refer to.

In claim 28, "the dehydrated and optionally washed filter cake of step (b)" lack(s) proper antecedent basis in the claim(s). Also, it is indefinite as to what "step (b)" refers to since no step is recited in claim 18 from which it depends.

In claim 29, "respectively" is indefinite as to what this is to mean or refer to.

In claim 30, "eloxal plants" is indefinite as to what these are.

In claim 31, it is indefinite as to what "step (b)" refers to since no step is recited in claim 18 from which it indirectly depends.

In claim 31, "the filter cake suspended in water" lack(s) proper antecedent basis in the claim(s).

In claim 32, "the further mineral acid(s)" lack(s) proper antecedent basis in the claim(s).

In claim 32, "respectively" is indefinite as to what this is to mean or refer to.

In claim 32, "the suspension" lack(s) proper antecedent basis in the claim(s).

Claims 33,34 provide for the use of the product obtained by instant claim 18, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 33,34 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 18-34 appear allowable over the cited prior art of record none of which teaches or suggests the instantly claimed combination of process steps.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Bos whose telephone number is 703-308-2537. The examiner can normally be reached on M-F, 8AM-6PM but is on increased flexitime sch.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 703-308-3837. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'S. J. Bos', is positioned above the printed name.

Steven Bos
Primary Examiner
Art Unit 1754

sjb